

Date \_\_\_\_\_ Label No. \_\_\_\_\_  
I hereby certify that, on the date indicated above, this paper or fee was deposited with the U.S. Postal Service & that it was addressed for delivery to the Commissioner for Patents, P.O. ox 1450, Alexandria, VA 22313 by "Express Mail Post Office to Addressee" service.

Name (Print) \_\_\_\_\_

Signature

Docket No.: 02338/000A887-US0

For: **PROCEDURE TO CONTROL A TORQUE TRANSMISSION SYSTEM**

(4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The required terminal disclaimer is contained in a separate document being filed, together with the requisite fee, contemporaneously herewith.

Further, the October 2, 2003 decision specifies the following:

Petitioner should provide a full explanation for the delay from the date of abandonment until the date the instant petition was filed. Petitioner should provide evidence to establish the entire delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b).

It is respectfully submitted that the evidence and discussion provided below satisfy such specification and affirmatively establish that the entire delay from the date of abandonment until the date of the instant petition was filed was unintentional.

**A. Background**

Originally, a German language forerunner of the present application was sent 1/16/95 by a German corporation (hereinafter "LuK" or "client") to Peter K. Kontler (hereinafter "PKK"), with a copy for the Darby firm (hereinafter "Darby") in New York, together with an instruction that it be filed in the USPTO on or before 2/23/95. At that time, PKK was Of Counsel to Darby, but located in Naples, FL, not its New York City office. Copies of PKK's English language fax letters of 1/19/95 to Darby and LuK that succinctly memorialize the urgency of the situation are attached hereto behind Tab 1. Today, Darby has such file in its custody in New York City.

The undersigned avers, however, that the Darby file is not complete. It contains an unsigned draft of a declaration and power of attorney, but no copy of the signed version. Such draft names the partners of Darby, including Melvin C. Garner and Henry Sternberg (hereinafter "HS"), but does not mention PKK. Nor is there a copy of an associate power from a Darby partner to PKK.

**B. USPTO Office Action Mailed 11/12/96**

The USPTO office action of 11/12/96 was duly docketed by Darby on receipt and reported in the normal course to LuK by HS on 11/22/96. And, in his letter, HS expressly requested instructions by 1/12/97 and confirmation that PKK was to prepare the response. See the copy thereof attached hereto behind Tab 2.

LuK sent back its instructions on 2/6/97 with an explicit and unequivocal request that they and the Darby file be forwarded to PKK. HS had a copy of the office action sent to PKK on 3/6/97. It also appears that copies of HS' letter to LuK and its instructions back were faxed to PKK on 3/4/97. Copies of this correspondence are attached hereto behind Tab 3.<sup>1</sup>

In a 5/12/97 e-mail, Gail Pelkowski, then a Darby paralegal, informed Gabriela Karaszi, then a Darby docketing person, as follows:

**I spoke with Mr. Kontler today regarding the response to the office action due today for file no. 2238/0A887-US0, S.N. 08/392,127. Mr. Kontler is working on the response. He intends to fax it to the PTO himself this evening.**

See the copy attached hereto behind Tab 4. Also, Darby invoice no. 175900, dated 7/25/97, a redacted copy of which is attached hereto behind Tab 5, contains a line as follows:

**5/12/97 Several telecoms HS with PKK**

**But the USPTO table of contents for its corresponding file reflects no receipt of any PKK response to the 11/12/96 office action. A copy of the table of contents is attached hereto behind Tab 6.**

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<sup>1</sup> Note should be taken that only the first paragraphs of the 2/6/97 letter have been translated into English from German, because, effectively, the rest of the 2/6/97 letter from client to counsel that sought to advance the prosecution of the present application in the USPTO was put into English and incorporated in the amendment filed with the 7/29/03 petition to revive herein; accordingly, such translation requires no repetition here.

It should also be noted that all of the documents attached hereto behind Tabs 1 to 16 are included for the relevant facts that they evidence. To the extent that such documents contain attorney fee information or requests for, or offers of, legal advice or opinion, they have been redacted.

A possible explanation of the foregoing chain of events is that PKK did in fact fax his response to the USPTO, but it deemed the submission a nullity because PKK lacked any corresponding power of attorney. However, nothing in the Darby file or what the undersigned has seen of the USPTO file substantiates this. The other possibility is that PKK sent no fax, or any other form of a, response to the USPTO office action of 11/12/96 at any time. Notwithstanding our diligent attempts to investigate the matter with Mr. Kontler, we have had no response from him concerning this omission.

**C. USPTO Notice of Abandonment Mailed 5/27/97**

On 5/27/97, the Darby & Darby Docket Manuel 1995 authoritatively spelled out the applicable procedure or rules governing the firm's docketing function. Copies of the manual's title page, its Table of Contents page i to v and its subsection B. Notice of Abandonment is Received from USPTO (pages 37 and 38) are attached hereto behind Tab 7.

Numbered sub-paragraphs 5 to 7 of such sub-paragraph B plainly required that Darby's actual receipt of any and all notices like the subject 5/27/97 USPTO notice of abandonment must be memorialized in several ways, i.e.,

- 1) entry in PATTSY (the Darby docketing computer);
- 2) entry in its IDB (hard-cover Incoming Docketing book);
- 3) entry on the cover of the Darby case file; and
- 4) an entry of the Docketing Department's "due date" stamp on the notice itself.

There is a reason why Darby has built such a redundancy into its docketing system. It is to make sure that everyone at the firm coming into contact with a patent application has received some form of notice of the notice of abandonment. It is also to make sure a repetition of the any past failure to respond timely by one or the other of the prior response due dates is prevented. It is to prevent what would, in the worst circumstances, turn out to be an irretrievable loss to the client and Darby. Clearly, the Darby docketing ideal is that no notice of abandonment response due date should be allowed to escape attention and, to this end, should be red-flagged throughout the Darby docketing system.

**But such ideal was defeated in this case; there was here no compliance with a single one of the four above-recited requirements.**

Behind Tab 8 attached hereto is a copy of a computer print screen of this case showing no entry of the 5/27/97 notice of abandonment. Behind Tab 9 hereof is a copy of the Darby IDB page<sup>2</sup> that should have shown, but did not, the 5/28/98 due date for response to such notice. Behind Tab 10 is a copy of the Darby file cover for this case, showing no entry for such notice. Behind Tab 11 is a copy of the Darby file copy of the 5/27/97 notice of abandonment from which the prescribed Darby Docketing "due stamp" is entirely missing. **Thus, each and every Darby specified docketing requirement for such a USPTO notice was violated in this case due to clerical errors, and as a consequence, this negated the client's intention to respond to the office action of 11/12/96 and maintain pendency.**

For stark contrast, the facts are that the USPTO office action of 11/12/96 (a copy of the first page of the file copy of which is attached behind Tab 12) bears the Darby docketing "due date" stamp and was otherwise duly docketed in compliance with parallel Darby procedures. Cf., attached Tabs 8 and 10 and note that the computer print screen of Tab 8 expressly sets forth both USPTO due dates, i.e., 2/12/97 and 5/12/97, for response to the office action of 11/12/96. See, also, Tab 13 behind which are copies of the Darby IDB pages highlighted to show such 2/12/97 and 5/12/97 due dates for response to such office action.

Notwithstanding the foregoing demonstration that the 5/27/97 notice of abandonment was never formally docketed by Darby, the existence of the notice was timely, if informally, brought to the attention of HS and PKK. See the copy of the two-page 6/4/97 fax sent by Ema Gualano, secretary to HS, to PKK that is attached hereto behind Tab 14.

The undersigned avers that there is nothing in the Darby file of this case that reflects any PKK reaction whatsoever to such 6/4/97 fax.

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<sup>2</sup> Note that it was then Darby Docketing's practice to re-use certain pages of its 1997 IDB for 1998 due dates and certain pages of its 1996 IDB for 1997 due dates.



kind thereto and, further, there is therein no evidence that contradicts either of the client's above-noted assertions of no prior knowledge.

More generally, the documents behind Tab 16 establish that anxiety was full-blown by 5/15/03 about whether PKK had filed a timely response to the office action of 11/12/96. Note, in particular, the tone of HS' 5/15/03 letter to PKK requesting information about such response and acknowledging the lack of a copy in Darby's New York City office. But PKK did not respond, and has remained entirely unresponsive.

## E. Conclusion

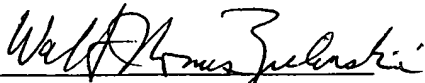
It is respectfully submitted that there is no proof anywhere that there has been any intentional delay in the filing of the petition to revive in this case. The present record clearly proves that the present petition to revive was not intentionally delayed at any time beginning with the response due date for the 11/12/96 office action and up to the actual 7/29/03 filing date of the petition to revive and this response. It may or may not show inadequate communication between client and counsel or among counsel but these are not the issues to be decided here. The sole issue is delay and it was purely and entirely unintentional. Accordingly, reconsideration and withdrawal of the dismissal of such petition, and its early grant, are respectfully solicited.

All statements made herein of the undersigned's knowledge are true, and all statements made on information and belief are believed to be true; and further the statements were made with the knowledge that willful statements and the like are made punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that

such willful false statements may jeopardize the validity of the present application or any patent issuing thereon.

Respectfully submitted,

Dated: December 1, 2003

  
Walt Thomas Zielinski  
Reg. No. 18,902  
Attorney for Petitioners

DARBY & DARBY, P.C.  
Post Office Box 5257  
New York, N.Y. 10150-5257  
Phone (212) 527-7700

1

01/19/95

19:09

81 813 434 6747

KONTLER

DARBY

001/008

2338/0A887

PETER K. KONTLER

4401 Gulf Shore Blvd. N.  
Naples, Florida 33940

BY TELECOPIER ON 1/19/95

████████████████████  
Melvin C. Garner, Esq.  
DARBY & DARBY, P.C.  
805 Third Avenue  
New York, N.Y. 10022-7513

Re: New US patent application of  
Messrs. Robert FISCHER et al.  
assigned to LuK Getriebe-Systeme GmbH  
LuK File GS 0115/04/012 B US  
Priority dated February 23, 1994

Dear Mr. Garner:

Enclosed please find a copy of a cover letter which  
was received today, together with a German text including  
111 pages and 39 Figures. Please let me know the D&D File  
Number of the case. Thank you.

The LuK letter of January 16, 1995 contains the  
statement that another application, having the same priority,  
is now in preparation in Germany and is expected to be sent  
to me in the near future. I will send you a copy of the  
letter which will accompany the new application immediately  
upon receipt.

Yours very truly,

*Peter K. Kontler*

Peter K. Kontler

Enclosures:  
(5 pp.)

PETER K. KONTLER

PATENT LAWYER

4401 GULF SHORE BOULEVARD NORTH  
NAPLES, FLORIDA 33940

PER FERNSCHREIBEN AM 19.1.95

TELEPHONE: 813 262-8492  
TELEFAX: 813 434-6747

Herrn Dipl.-Ing. Gerhard Rotter  
Leiter der Patentabteilung  
LuK Lamellen und Kupplungsbau GmbH  
Industriestrasse 3  
D-77815 Bühl/Baden  
Bundesrepublik Deutschland

Re: New US patent application  
of Messrs. Robert FISCHER et al.  
Ihr Neuer Zeichen GS 0115/24/012 B US  
(LuK Getriebe-Systeme GmbH)

Dear Mr. Rotter:

Thank you for your letter of January 16, 1995  
with enclosures (received January 19, 1995).

The US patent application is in preparation and  
will be filed in the US Patent and Trademark Office prior to  
expiration of the Convention priority period.

I would appreciate receiving the necessary documents  
for the preparation of the new US patent application corres-  
ponding to your case GS 0116\*B at your early convenience.  
Thank you.

Please send me prints of DE-OS 31 30 871 (mentioned  
in line 1 on page 24 and elsewhere in your German text) and  
DE-PS 37 12 223 (mentioned in line 10 on page 26 and elsewhere  
in the German text), preferably by telecopier (if they are  
not too bulky). You may also wish to send me prints of  
US patents Nos. 5,029,087 and 5,577,737 (referred to, res-  
pectively, in lines 11 and 19 on page 24 and elsewhere in  
your German text). Please let me know if the US patents  
are too bulky for sending by telecopier, and I will order  
copies of such patents from my Washington correspondents.

I wish to thank you for entrusting me with the pre-  
paration of the US patent application, and remain,

yours faithfully,

  
Peter K. Kontler

2

# Darby & Darby

Professional Corporation

805 Third Avenue • New York, NY 10022-7513  
Phone: (212) 527-7700 • Fax: (212) 753-6237

707 Wilshire Boulevard • Los Angeles, CA 90017-3514  
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Writer's Direct Dial:  
(212) 527-7755

Reference:  
2338/OA887

VIA DHL

Herrn Dipl.-Ing. Gerhard Rotter  
Leiter der Patentabteilung  
LuK Lamellen und Kupplungsbau GmbH  
D-77813 Bühl  
Federal Republic Germany

Re: U.S. Serial No. 08/392,127  
For: METHOD OF AND APPARATUS FOR  
TRANSMITTING TORQUE IN VEHICULAR  
POWER TRAINS  
Your Ref: GS 0115/04/012 B US

Dear Mr. Rotter:

Enclosed is a copy of an Official Action dated 12 November 1996.

Claims 41-101 stand withdrawn from further consideration as being directed to non-elected inventions.

Claims 1-40 stand rejected under Section 112, second paragraph, as being indefinite.

Claims 1-40 stand further rejected under Section 112, first paragraph. The Examiner has taken the position that although determination of factors  $K_{max}$ ,  $M_{max}$  and  $M_{min}$  are critical to the claimed invention, there is not enough guidance by the present disclosure regarding selection or determination of the above factors to enable one of ordinary skill in the art to make and use the present invention.

The Examiner has further taken the position that it is not possible to reasonably interpret the scope of the claims in light of the alleged deficiencies cited above so that no prior art has been cited at this time.

Byard G. Nilsson\*  
William F. Dudine, Jr.  
Michael J. Sweedler  
S. Peter Ludwig  
Paul Fields  
Harold E. Wurst\*  
Joseph B. Lerch  
Melvin C. Garner  
Ethan Horwitz  
Beverly B. Goodwin  
Adda C. Gogoris  
Martin E. Goldstein  
Bert J. Lewen  
Henry Sternberg  
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Robert Schaffer  
David R. Francescani  
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Reza Green, PhD  
David E. Wildman, PhD  
A. David Joran, PhD

\* Admitted in California only  
† Admitted in Virginia only  
‡ Admitted in DC and  
Pennsylvania only  
° Admitted in Nebraska only  
\*\* Admitted in Florida only

Morris Relson (1948-1996)

November 22, 1996

Herrn Dipl.-Ing. Gerhard Rotter

Page 2

November 22, 1996

A response to the Official Action must be filed no later than 12 February 1997, if late fees are to be avoided.

Please let us have your instructions no later than 12 January 1997. At that time, also please confirm that you wish the response to be prepared by Mr. Kontler.

Sincerely,

Henry Sternberg

HS/kmw  
Enclosure

3

Translation of the beginning of attached letter on LuK  
letterhead, up to "Sehr geehrter Herr Kontler"

---

VIA TELECOPIER

Darby & Darby  
Professional Corporation  
Attn. Mr. H. Sternberg  
805 Third Avenue  
NEW YORK, NY 10022-7513  
USA

Bühl, February 6, 1997

US Patent Application No. 08/392,127  
Title: "Method of Controlling a Torque-Transmitting System"  
Your Reference: 2338/0A887  
Our Reference: GS 0115/04/012 B US

Dear Mr. Sternberg:

May we ask you to send the aforementioned file to Mr. Kontler  
for the continuation of the work in this matter.

Dear Mr. Kontler:

November 3, 2003

To Whom It May Concern:

The undersigned hereby declares that he has personally translated the attached documents:

Portions of fax from Dr. H. Grauel, LuK, to Henry Sternberg, dated February 6, 1997,

Fax from Mr. Ronnenberg, LuK, to Henry Sternberg, dated April 2, 2003, and

Fax from Mr. Rotter, LuK, to Henry Sternberg, dated May 15, 2003

and that they are accurate translations of the German documents that are attached to them.

A handwritten signature in cursive script, reading "Walter Kupper", written in black ink. The signature is fluid and stylized, with a long horizontal line extending from the end of the name.

Walter Kupper  
Registered Patent Agent  
USPTO Reg. No. 34,954

KUPPLUNGEN · TELLERFEDERN · LAMELLEN



LAMELLEN UND  
KUPPLUNGSBAU GMBH

By Telecopier # 723

LuK Lamellen und Kupplungsbau GmbH - 77813 Bühl

DARBY & DARBY  
Professional Corporation  
Attn. Mr. Henry Sternberg  
805 Third Avenue  
New York, N.Y. 10022-7513

Ø H. Kontler

USA

Telefon: (072 23) 9 41-0  
Fax: (072 23) 2 88 50

Lieferanschrift:  
Industriestraße 3  
77813 Bühl

Ihr Zeichen/Ihre Nachricht vom

Abteilung/Bearbeiter

Telefon (Durchwahl)  
941-

Fax (Durchwahl)  
941-

Bühl, den

PT/Gr-ach

410/411

6. Februar 1997

**US-Patentanmeldung Nr. 08/392,127**  
**Ihr Zeichen: 2338/0A887**  
**Unser Zeichen: GS 0115/04/012 B US**

Sehr geehrter Herr Sternberg,

wir bitten Sie, obige Akte Herrn Kontler zur weiteren Bearbeitung zu übersenden.

Sehr geehrter Herr Kontler,

wir kommen zurück auf das Schreiben von Darby & Darby vom 22.11.96 bezüglich des Prüfungsbescheides vom 12.11.96.

Bezüglich des Punktes 6 sei bemerkt, daß die fehlende Anmeldenummer 08/375,913 ist.

Bitte erledigen Sie die Beanstandung bezüglich der Tabelle auf S. 97 von sich aus.

Unter Punkt 7 führt der Prüfer eine Reihe von Unklarheiten an. Hierzu nehmen wir wie folgt Stellung:

Zu 7.1.

Bitte erledigen Sie diesen Punkt von sich aus. Der Prüfer rügt, daß das Drehmoment des Antriebsaggregates unterschiedlich ist zu dem von der Kupplung übertragbaren

Drehmoment, wobei durch die Ansteuerung des Kupplungsmomentes ja erst der Wert des übertragbaren Drehmomentes festgelegt wird, unabhängig davon, wie groß das anstehende Motormoment ist. Somit sollte deutlich sein, daß das Motormoment und das Kupplungsmoment nicht zwingend gleich sein müssen.

Zu 7.2:

Bitte nehmen Sie in den Anspruch 2 die vom Prüfer geforderten Schritte zur Bestimmung der Korrekturwerte auf. Die Korrektur des  $k_{me}$ -Wertes durch den Korrekturwert  $k_{corr}$  sorgt dafür, daß ein im wesentlichen fest gewählter  $k_{me}$ -Wert durch den Korrekturfaktor entsprechend der Figur 27 betriebspunktabhängig wird. Das Produkt  $k_{me} \times k_{corr}$  ist somit abhängig von dem aktuellen Betriebspunkt, also beispielsweise von der Motordrehzahl oder dem Motormoment oder von anderen Größen.

Zu 7.3:

Bitte ändern Sie die Rückbeziehungen des Anspruches 6, so daß der Anspruch 6 auf Anspruch 2 rückbezogen ist.

Zu 7.4:

Bitte erledigen Sie diesen Punkt unter Berücksichtigung der ursprünglichen deutschen Ansprüche 9 und 10 von sich aus.

Zu 7.5:

Statt „eine eindeutig durch eine nicht analytische Technik beschrieben werden“ sollte es heißen: „kann nicht eindeutig analytisch beschrieben werden“.

Zu 7.6:

Entsprechend dem ursprünglichen Anspruch 13 sollte es in Anspruch 15 nicht heißen „establishing an I return flow of fluid from one of the compartments into the other of the compartments“, sondern „by establishing an I feed-back, ...“. Die I-Rückführung stellt somit ein regelungstechnisches Element dar, bei welchem einem PID-Regler der I-Anteil alleine rückgeführt wird. Somit liegt ein I-Regler vor.

Zu 7.7:

Bitte erledigen Sie diesen Punkt von sich aus.

**Zu 7.8:**

Anspruch 22 sollte dahingehend geändert werden, daß bei einer Signalisierung einer gewünschten Beschleunigung des Fahrzeuges durch den Fahrer, der Schlupf in der Kupplung erhöht wird, und dies wird mittels einer Reduzierung des  $k_{me}$  - Faktors erreicht und dadurch wird die vom Wandler angebotene Drehmomenterhöhung als zusätzliche Drehmomentreserve genutzt. Insofern ist die Nutzung der Antriebseinheit in verschiedenen Gängen in diesem Anspruch nicht nötig.

**Zu 7.9:**

Bitte beheben Sie diese Beanstandung von sich aus.

**Zu 7.10:**

Der Anspruch 24 ist aufgrund seines nahezu identischen Wortlautes und seines gleichen Sinngehaltes zu streichen. Falls Sie einen Unterschied zwischen Anspruch 23 und 24 sehen, möchten wir Sie bitten, uns diesen mitzuteilen.

**Zu 7.11:**

Bitte streichen Sie die Formulierung „such as a combustion engine“. Statt dem Wort „variable“ in Zeile 9 des Anspruches 25, sollte es besser heißen: „by the clutch is detectable by a monitoring unit in conjunction with a central computer unit and variable by the computer unit and ...“. Weiterhin sollte in den Anspruch 25 die Bestimmung der Korrekturfaktoren aufgenommen sein. Weiterhin rügt der Prüfer, daß der  $k_{me}$  - Faktor zumindest im wesentlichen über den gesamten Betriebsbereich des Fahrzeuges konstant ist. Dies kann in dem vorliegenden Anspruch gestrichen werden, wobei erwähnt sein sollte, daß das Produkt von  $k_{me} \times k_{corr}$  nicht konstant sein muß. Weiterhin rügt der Prüfer den Anspruch 25 ab Zeile 24 als nicht klar. Wir möchten Sie bitten, diesen Absatz entsprechend umzuformulieren, damit die Passage dem letzten Absatz des Anspruches 21 der deutschen Unterlagen entspricht und die vom Prüfer gerügte Unklarheit beseitigt ist.

**Zu 7.12:**

Bitte passen Sie die Ansprüche 26 bis 29 entsprechend dem Obengesagten an.

**7.13 bis 7.22:**

Bitte erledigen Sie diese Punkte von sich aus.

Der Prüfer weist unter Punkt 8 die Ansprüche 1 bis 40 zurück, da er der Ansicht ist, daß diese Elemente enthalten, die nicht in der Beschreibung derart offenbart sind, daß sie der Fachmann nachvollziehen kann. Weiterhin rügt der Prüfer, daß die Korrekturfaktoren  $k_{\text{corr}}$ ,  $M_{\text{corr PM}}$  und  $M_{\text{corr WO}}$  nicht ausreichend offenbart sind.

Nach diesseitiger Auffassung ist sowohl in den Ansprüchen als auch in der Beschreibung genügend Offenbarung vorhanden zum einen, wie die Werte gewonnen werden, nämlich entsprechend der Figur 29 und die Verwendung entsprechend den Figuren 28 und 30. Weiterhin wird mehrmals im Text der Beschreibung ausgeführt, daß Korrekturfaktoren, wie beispielsweise der  $k_{\text{me}}$ -Wert oder ein  $k_{\text{corr}}$  einen vorbestimmten Wert annehmen kann oder um einen solchen vorbestimmten Wert vermindert werden kann. Insbesondere auf S. 54 der deutschen Beschreibung wird ausgeführt, daß die Korrekturfaktoren in verschiedenen Betriebsbereichen unterschiedlich gewichtet werden und daß beispielsweise der  $k_{\text{me}}$ -Wert oder die Korrekturfaktoren aus Kennfeldern herausgenommen werden können (s. S. 92 des ursprünglichen deutschen Textes).

In unserer Anmeldung GS 0104 (05/03) A PCT/US sind im wesentlichen ähnliche Ansprüche enthalten, die von der Prüferin als erteilbar erachtet werden. Somit sollten die Korrekturfaktoren, da in der GS 0104 (05/03) A PCT/US ausreichend offenbart, auch in der vorliegenden Anmeldung ausreichend offenbart sein.

Falls Sie bezüglich der Bearbeitung der vorliegenden Anmeldeunterlagen noch Fragen haben, rufen Sie mich bitte an.

Mit freundlichen Grüßen

LuK  
Lamellen und Kupplungsbau GmbH  
- Patentabteilung -  
Dr. A. Grauel



ANNETTE MASIELLO PATENT  
AND TRADEMARK SERVICES  
2001 Jefferson Davis Hwy.  
Suite 1011  
Arlington, VA 22202

Telephone: 703-415-3060

Fascimile: 703-415-3066

Please deliver the following pages to:

NAME: Peter K. Kontler, Esq. DOCKET: 2338/OA887  
COMPANY: Darby & Darby DEPARTMENT: \_\_\_\_\_  
FAX NUMBER: 941-434-6747 FAX OPERATOR: rkap  
SENDER: Annette Masiello DATE/TIME: 3/6/97 - 4:10 pm

We are transmitting a total of 12 pages including this cover page.

If you have any trouble receiving this message, please call the above immediately at 703-415-3060 or FAX us at 703-415-3066.

MESSAGE:

Dear Mr. Kontler,

Please find enclosed copy of cover and contents pages of the file history of U. S. Patent Application S. N. 08/392,127, Fischer et al as well as a copy of Paper No. 8, Rejection, dated November 12, 1996. This office action is being forwarded to you directly at the request of Henry Sternberg, Esq. of Darby & Darby of New York City, New York. Please feel free to call us if you have any questions.

Very truly yours,

Annette Masiello

RECEIVED

MAR - 6 1997

GROUP 2300

2338/OA887

COPY  
RECEIVED

MAR - 6 1997

GROUP 2300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

ROBERT FISCHER, ET AL.

Serial No: 08/392,127

Examiner: N. Jensen

Filed: February 22, 1995

Group Art Unit: 3502

For: METHOD OF AND APPARATUS FOR TRANSMITTING  
TORQUE IN VEHICULAR POWER TRAINS

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**POWER TO INSPECT**

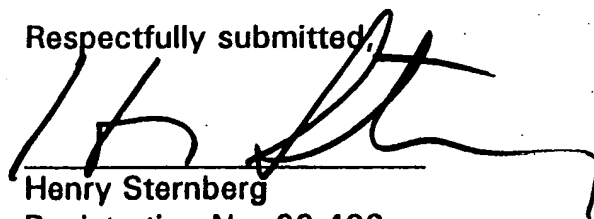
Hon. Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Sir:

Please permit Annette Masiello and/or Rayline Petitt of Annette Masiello

Patent Services to inspect the file for the above-identified application and to make  
copies of any of the documents in the file.

Respectfully submitted,



Henry Sternberg  
Registration No. 22,408  
Attorney for Applicant(s)

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New York, NY 10022  
(212) 527-7755

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2338/0A887

Ms. Annette Masiello  
Annette Masiello Patent Service  
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Morris Reison (1948-1996)

March 4, 1997

FACSIMILE TRANSMISSION  
To: MR. Peter K. Kontler  
Fax No. 941-434-6747  
From: H. Sternberg, Esq.  
No. of Pages 1

Re: U.S. Patent Application  
Serial No. 08/392,127  
For: METHOD OF AND APPARATUS FOR TRANSMITTING  
TORQUE IN VEHICULAR POWER TRAINS

Dear Annette:

Please obtain for us a copy of the Official Action dated November 12, 1996, in the above-identified application. As soon as you have it, please fax a copy to Mr. Kontler at 941-434-6747. A Power to Inspect is enclosed.

Sincerely,

Henry Sternberg

HS/eag  
Enclosure

cc: Peter K. Kontler, Esq.

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2338/0A887

*Call*  
*DKK*  
*has*  
*7/6 3/21*

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Morris Nelson (1948-1996)

March 4, 1997

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Henry Sternberg

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Enclosure

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Morris Nelson (1948-1996)

## FACSIMILE TRANSMISSION

To: Mr. Kontler  
Fax No. 941-262-8492  
From: H. Sternberg, ESQ  
No. of Pages 2

## VIA DHL

Herrn Dipl.-Ing. Gerhard Rotter  
Leiter der Patentabteilung  
LuK Lamellen und Kupplungsbau GmbH  
D-77813 Bühl  
Federal Republic Germany

Re: U.S. Serial No. 08/392,127  
For: METHOD OF AND APPARATUS FOR  
TRANSMITTING TORQUE IN VEHICULAR  
POWER TRAINS  
Your Ref: GS 0115/04/012 B US

Dear Mr. Rotter:

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Claims 41-101 stand withdrawn from further consideration as being directed to non-elected inventions.

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PKK  
Ph note.

Herrn Dipl.-Ing. Gerhard Rotter

Page 2

November 22, 1996

A response to the Official Action must be filed no later than 12 February 1997, if late fees are to be avoided.

Please let us have your instructions no later than 12 January 1997. At that time, also please confirm that you wish the response to be prepared by Mr. Kontler.

Sincerely,

Henry Sternberg

HS/kmw  
Enclosure

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2338/OA887

Ms. Annette Masiello  
Annette Masiello Patent Service  
2001 Jefferson Davis Highway  
Suite 1011  
Arlington, VA 22202

March 4, 1997

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TO: MR. Peter K. Kontler

FROM: H. Sternberg, Esq.

NO. OF PAGES 1

Re: U.S. Patent Application  
Serial No. 08/392,127

For: METHOD OF AND APPARATUS FOR TRANSMITTING  
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Sincerely,

Henry Sternberg

HS/eag  
Enclosure

cc: Peter K. Kontler, Esq.

MA2338/OA887/EA05625

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Morris Relson (1948-1996)

March 4, 1997

FACSIMILE TRANSMISSION

TO: MR. Peter K. Kontler  
Fax No. 941-434-6747  
From: H. Sternberg, Esq.  
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Ms. Annette Masiello  
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2001 Jefferson Davis Highway  
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Re: U.S. Patent Application  
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HS/eag  
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cc: Peter K. Kontler, Esq.

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Morris Nelson (1945-1996)

VIA DHL

Herrn Dipl.-Ing. Gerhard Rotter  
Leiter der Patentabteilung  
LuK Lamellen und Kupplungsbau GmbH  
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Federal Republic Germany

FACSIMILE TRANSMISSION  
To: Mr. Kontler  
Fax No. 941-262-8492  
From: H. Stenberg, ESQ  
No. of Pages 2

Re: U.S. Serial No. 08/392,127  
For: METHOD OF AND APPARATUS FOR  
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PKK  
Ph note.

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Morris Nelson (1948-1996)

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Sincerely,

HS/kmw  
Enclosure

Henry Sternberg

4

**From:** Gpelkows  
**To:** gkaraszi  
**Date:** Monday, May 12, 1997 12:21 pm  
**Subject:** 2338/0A887-US0

I spoke with Mr. Kontler today regarding the response to the Office Action due today for File No. 2338/0A887-US0, S.N. 08/392,127. Mr. Kontler is working on the response. He intends to fax it to the PTO himself this evening.

5

IN ACCOUNT WITH  
DARBY & DARBY  
PROFESSIONAL CORPORATION

803 THIRD AVENUE  
NEW YORK, N.Y. 10022-7513  
(212) 527-7700

CLIENT NUMBER 2338  
INVOICE NUMBER 175900

ATTORNEYS AT LAW

LuK Incorporated  
3401 Old Airport Road  
P.O. Box 798  
Wooster, Ohio 44691

FILE COPY

July 25, 1997

0A887- PROFESSIONAL SERVICES RENDERED THROUGH  
MAY 30, 1997 IN CONNECTION WITH THE  
FOLLOWING MATTER:

U.S. PATENT APPLICATION  
PROCEDURE TO CONTROL A TORQUE  
TRANSMISSION SYSTEM  
ASSIGNEE: LuK GETRIEBE SYSTEMS  
INVENTORS: FISCHER ET AL.  
YOUR REF: GS 0115/04/0128 US

11/22/96 Reporting Office Action and requesting instructions  
for response.  
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PATENT APPLICATION



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1. Application 24 papers.

2. Priority Papers

3. CD Coll FRD

1-11 4. Restriction (30 days)

3/19 5. Election

6. Restriction 30 days

7/1 7. Response to Restriction

11-8 8. Ref (3)

9. Power to inspect

5-27 10. notice of abandonment

11. Power to inspect

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GROUP 330

### INDEX OF CLAIMS

Claim	Final	Original	Date
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#### SYMBOLS

- ✓ Rejected
- Allowed
- (Through numeral) Cancelled
- + Restricted
- N Non-elected
- I Interference
- A Appeal
- O Objected

7

11/95

Fix Table  
of Contents

**DARBY & DARBY**

**DOCKETING MANUAL**

**1995**

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2. Forwarded remaining copies to Patent Services who will forward them to the client.

#### **XIV. Abandonment**

##### **A. Application is Abandoned at Client's Request**

1. If application is abandoned by the request of the Client, forward the file to Docketing with the client's letter.
2. Update the "Status" field in PATTSY to reflect the abandonment.
3. Update the file cover.
4. Cross out any due date entries in the IDB.
5. Forward the file to the Records Department.
6. If there are pending related cases, the file remains in the file room. If not, send the file to the responsible attorney with a file storage memo attached, so that it can then be routed to storage.

##### **B. Notice of Abandonment is Received from the USPTO**

1. The Records Department stamps the back of the document, pulls file and forwards it to Docketing.
2. Check the Serial Number with the file to insure they are accurate.
3. Check the reason for the Notice of Abandonment.
4. If the Notice was issued in error, attach a "Memorandum re Notice of Abandonment Advisory" sheet.
5. Docket the due date in PATTSY and the IDB for 1 year from the due date up to which an extension was paid (or from 1 year from the Notice), for submitting a Petition to Revive.
6. Stamp the Notice with the "Due Date" stamp.
7. Update the file cover with the pertinent information.
8. Forward the file to the responsible attorney.

**C. Petition to Revive**

1. If the Patent was mistakenly abandoned a Petition to Revive needs to be filed with the USPTO. The following circumstances are reasons that a patent would be abandoned in error:
  - a. USPTO error;
  - b. non-payment of maintenance fee; or
  - c. failing to respond to an outstanding Office Action.
2. All Petitions to Revive files are forwarded to Joseph Lerch.

**XV. Maintenance Fees**

**A. Docketing Maintenance Fees**

1. Applications filed on or after December 12, 1980 have the following Maintenance Fees due:
  - a. at 3.5 years;
  - b. 7.5 years; and
  - c. 11.5 years, provided maintenance fees are paid.
2. A United States Patent expires after 17 years.

**B. USPTO Maintenance Fee Receipt Received**

Forward the Receipt to Patent Services for handling.

**XVI. Communication from the Examiner is Received from the USPTO**

**A. General Information**

1. Normally a Communication does not require a response.
2. There are exceptions to this rule. One example of an exception is that a Reply Brief was submitted to the USPTO and this Communication noted that it will not be entered (see 37 CFR 1.181 for a description on how to handle this matter).

2. Forwarded remaining copies to Patent Services who will forward them to the client.

#### **XIV. Abandonment**

##### **A. Application is Abandoned at Client's Request**

1. If application is abandoned by the request of the Client, forward the file to Docketing with the client's letter.
2. Update the "Status" field in PATTSY to reflect the abandonment.
3. Update the file cover.
4. Cross out any due date entries in the IDB.
5. Forward the file to the Records Department.
6. If there are pending related cases, the file remains in the file room. If not, send the file to the responsible attorney with a file storage memo attached, so that it can then be routed to storage.

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1. The Records Department stamps the back of the document, pulls file and forwards it to Docketing.
2. Check the Serial Number with the file to insure they are accurate.
3. Check the reason for the Notice of Abandonment.
4. If the Notice was issued in error, attach a "Memorandum re Notice of Abandonment Advisory" sheet.
5. Docket the due date in PATTSY and the IDB for 1 year from the due date up to which an extension was paid (or from 1 year from the Notice), for submitting a Petition to Revive.
6. Stamp the Notice with the "Due Date" stamp.
7. Update the file cover with the pertinent information.
8. Forward the file to the responsible attorney.

8

Darby# 000A887-US0

PRINTED ON: 10/31/2003

COUNTRY	US	UNITED STATES	TITLE		PRIOR	2/23/1994	
NEW/CON	NEW	SERIAL#	08/392,127	METHOD OF AND APPARATUS FOR TRANSMITTING TORQUE IN VEHICULAR POWER TRAINS	MAIL	2/22/1995	
RELATED		PATENT#			FILE	2/22/1995	
TYPE	UTL	STATUS	PENDING		PUBL		
CLIENT	03192	LuK Getriebe-Systeme GmbH	1	CREF	GS0115/04/012B US	ISSUE	
AGENT				AREF		1ST	2/22/1995
						EXP	

ID	O	ACTION	BASE	DUE IN	DUE	EXTNS	FINAL	EXT	RESPONSE	CALL UP	1	2	P
DL	N	PRIORITY DEADLINE	2/23/1994	12	M	2/23/1995		2/23/1995	0	2/22/1995	1	M	Y Y Y
SPEC, DECL, (24) INFML DWGS, PRI DOCS (4), ASSGN, PTO-1595, IDS													
CF	Y	CORRECT OF FLG RCPT	4/20/1995										
DS	N	INF DISCLOSURE STMT	2/22/1995	3	M	5/22/1995	0	5/22/1995	0	2/22/1995	1	M	Y Y N
6 REFS													
RR	N	RESTRICTION REQUIRE	1/18/1996	30	D	2/17/1996	4	1	6/17/1996	0	2/14/1996	1	M Y Y N
RR	N	RESTRICTION REQUIRE	5/23/1996	30	D	6/22/1996	4	1	10/22/1996	0	6/18/1996	1	M Y Y N
RE	N	RESPONSE TO OA	11/12/1996	3	M	2/12/1997	3	1	5/12/1997	3	7/29/2003	1	M Y Y N
PROPOSED RESP, WITH PETITION TO REVIVE(?) BY HAND													
PE	Y	PETITION	7/29/2003										
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DISMISSED													
QR	N	REQ RECONSIDERATION	10/2/2003	2	M	12/2/2003	4	1	4/2/2004	0		1	M Y Y N

## INVENTORS

ROBERT FISCHER; UWE WAGNER;

JURGEN FREITAG;

JOHANNES BRAUN; ANTON RINK

## ASSIGNEES

LUK-GETRIEBE-SYSTEME GMBH

REC DATE 02/22/95 R/F 7370/0711

## USER-DEFINABLE FIELDS

TEXT 1	
TEXT 2	
Old#	0A887US0

## PATENT FIELDS

SMALL ENTITY	no	ART UNIT	
CLAIMS		EXAMINER	
PUBLICATION#		CONFIRM#	

P0A887US00 ENTERED 1/20/1995 MODIFIED 10/10/2003 BY DBP ATTORNEYS JRR / HS / IH / HS

## FILE LOCATION

FILE/SUBFILE#

LOC

0A887US0	SJM
0A887US0V1	WTZ
000A887-US0	WTZ
000A887-US0R1	WTZ

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1995 147th day - 218 days

**TUESDAY**

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~~ANA 1030/1011 411 169,073 file opp 800 1000/1111~~  
~~KLS 1030/1011 411 169,073 file opp 800 1000/1111~~  
~~SPL 1030/1011 411 169,073 file opp 800 1000/1111~~  
~~ALN LRC 6870/30432 249,147 Anale to Oppose 5/27~~  
~~HR Caeser 1541/2005900 PCT/US98/05180 INV. D Corr. 5/26~~

~~ASTN Berggren 1329/00405 754,813 Issue Fee + dnps 5/21~~  
~~ELS Carr 0213/1A249 US 678,481 <sup>Renewed 2/21/98</sup> Issue Fee + dnps~~  
~~MAYH Harms Ulrich 1683/0A189 074,638 Issue Fee + dnps 5/21/98~~

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Entered\_

Docketed

Entered 1/20/95 *Em*

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**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/392,127	02/22/95	FISCHER	R 2338/0A887

DARBY AND DARBY  
805 THIRD AVENUE  
NEW YORK NY 10022

B3M1/0527

EXAMINER	
PARK, C	
ART UNIT	PAPER NUMBER
2304	10

DATE MAILED:

05/27/97

**NOTICE OF ABANDONMENT**

This application is abandoned in view of:

- ☒ Applicant's failure to respond to the Office letter, mailed 11/12/96.
- ☐ Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
- ☐ Applicant's failure to timely file the response received \_\_\_\_\_ within the period set in the Office letter.
- ☐ Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of \_\_\_\_\_ of the Notice of Allowance.
  - ☐ The issue fee was received on \_\_\_\_\_.
  - ☐ The issue fee has not been received in Allowed Files Branch as of \_\_\_\_\_.

In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17(l), and a verified showing as to the causes of the delay.

If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of *Delgar Inc. v. Schuyler*, 172 U.S.P.Q. 513.

- ☐ Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by \_\_\_\_\_ as required in the last Office action.
  - ☐ The corrected and/or substitute drawings were received on \_\_\_\_\_.
- ☐ The reason(s) below.

*Collin W. Park*

**COLLIN W. PARK**  
**PRIMARY EXAMINER**  
**GROUP 2300**

12



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/392,127 02/22/95 FISCHER

R 2338/0A887

EXAMINER

DARBY AND DARBY  
805 THIRD AVENUE  
NEW YORK NY 10022

E3M1/1112

**DATE:** February 12, 1997

ART UNIT PAPER NUMBER

**Docketed on** 11/19/96 **by** [signature] **for** 2304

**Docketed without fee** ☐

**DATE MAILED:** 11/12/96

11/12/97  
5/12/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☒ Responsive to communication filed on 6/21/96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.                 | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.                  |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/>  |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-101 are pending in the application.

Of the above, claims 41-101 are withdrawn from consideration.

2. ☐ Claims have been cancelled.

3. ☐ Claims are allowed.

4. ☒ Claims 1-40 are rejected.

5. ☐ Claims are objected to.

6. ☐ Claims are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed has been ☐ approved; ☐ disapproved (see explanation).

12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. filed on

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in

13

1997

1996 43rd day - 323 days follow  
Lincoln's Birthday

Wed

MONDAY

12

FEBRUARY

ALN CHEMICAL 5555/37502 1.634,974  
 AB HUNGRIA 7728/36262 1.634,860  
 SPL ELIAS 2985/28588 1.635,125  
 ALN PAPILL 6177/37058 1.634,820  
 SPL LONDON 6878/26252 1.634,663  
 BTL EVEN 3051/36979 1.634,725  
 BTL KUMARAN 1042/08819  
 ADD Recordate 6485/08087 No Lf Client Nox - Proddolln  
 RSL Shindellows 0762/180109 719,224  
 ASB PROMOTIONS 6411/30011 038,137  
 LPA MINDAXI 1031/30229 045,990  
 LPA KUMARAN 1011/30228 060,797  
 JLR LYNHAM 0046/08123 476,201  
 JANE LUIS 5422/70721 101,552  
 LPA BML 2408/90086 641,244  
 LPA CHAGALOW 5412/08934452  
 PRL U.S. Oiler 7771/06005 472,999  
 MYS YAMADA 8032/07546 907,926  
 MYS CHAGALOW 1955/08077 441,760  
 HSK UK 2338/0A887 392,127  
 JLR DYNAMID 0046/1A074US1 455,355  
 HS LUK 2338/78279US4 320,732  
 HS LUK 2338/09451 211,978  
 CRL ATTENDE 0522/00375 072,188  
 BSL CONZA 5408/00107  
 PRL EGO 2991/2047440 96,1845  
 BSL BACHE 1780/2042440 96,1844  
 HSK KALATE 3258/30394 061,557  
 KGH GONG 0665/08958 US3 561,341  
 KGH KRAFT 5520/0394 84,240  
 JCL PRY Hubbell 4335/62323 Peterson v Chubb's Chubb's + Hubbell Reply  
 MWH BETHLEHEM 1144/62293 MWH + U.  
 RSL LUK 2338/09277US1 533,110  
 JLR SAMPSON 1946/09013 231,622  
 JLR SAMPSON 3404/110440US5 425,133  
 MCE GORDON 5495/08139 437,700

RENEWAL 1/11

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IPN BAIL 2108/30086 CHI. 244 RENEWAL 19 DATE 12/4  
PRU U.S. 0700 1111 06005 472,999 Appeal allowed  
MAG Yamada 8032 107540 907926 Appeal allowed 4/7  
MAG Thompson 0999/36270 083,651 Smt 7 MONTHS 5/12  
MAG Thompson 1955/08022 441,700 Smt 7 MONTHS 5/12  
MAG LUK 2338/0A887 392,127 Smt 7 MONTHS 5/12  
MAG Yamada 0646/1A67451 455,355 Smt 7 MONTHS 5/12  
MAG O'Brien 0775/30889 078,124 Smt 6 of 452 5/12  
MAG Thompson 0999/36270 083,651 Smt 7 MONTHS 5/12  
HS LUK 2338/18279454 320,132 APPEAL 4/10  
HS LUK 2338/09451 211,978 APPEAL known  
JPL Attitude 0502/06375 012,188 Smt 7 MONTHS 2/10  
US KSB 1957/00014 716,391 DATE DEC. 14 1/0  
AS Thompson 1511/79815 Maria V. Morris 100,280 Defendant to close EXT 5/10  
HS Topack 0600/06697 JDS C/LY  
HS LUK 2338/06033 File Appeal 5/2  
Ruy Adaptive 0382/124913 US 92/03405 Resp to written opinion 5/2  
PRCH Jagger 1105/00161 (28 mos) File Appeal 5/1  
JL Thacker 0270/89102 Response to Subpoena 5/27

MAG Shumko 0476/06339 684,951 Resp to 4/23  
HS LUK 2338/09451 211,978 DATE DEC 5/9

14

From:  
To: gkaraszi  
Date: Monday, May 12, 1997 12:21 pm  
Subject: 2338/0A887-USO

I spoke with Mr. Kontler today regarding the response to the Office Action due today for File No. 2338/0A887-USO, S.N. 08/392,127. Mr. Kontler is working on the response. He intends to fax it to the PTO himself this evening.

MR. Kontler: 6/4/97  
Please let us know  
when you want  
to proceed with  
the petition to

Revoke?

Thank you -  
EMK



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/392,127	02/22/95	FISCHER	R 2338/0A887

DARBY AND DARBY  
805 THIRD AVENUE  
NEW YORK NY 10022

B3M1/0527

EXAMINER	
PARK, C	
ART UNIT	PAPER NUMBER
2304	10

DATE MAILED:

05/27/97

**NOTICE OF ABANDONMENT**

This application is abandoned in view of:

- ☒ Applicant's failure to respond to the Office letter, mailed 11/12/96.
- ☐ Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
- ☐ Applicant's failure to timely file the response received \_\_\_\_\_ within the period set in the Office letter.
- ☐ Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of \_\_\_\_\_ of the Notice of Allowance.
  - ☐ The issue fee was received on \_\_\_\_\_.
  - ☐ The issue fee has not been received in Allowed Files Branch as of \_\_\_\_\_.

In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17(l), and a verified showing as to the causes of the delay.

If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of *Delgar Inc. v. Schuyler*, 172 U.S.P.Q. 513.

- ☐ Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by \_\_\_\_\_ as required in the last Office action.
  - ☐ The corrected and/or substitute drawings were received on \_\_\_\_\_.
- ☐ The reason(s) below.

**FACSIMILE TRANSMISSION**

To: Mr. Kontler  
Fax No. 941-434 6747  
From: H. Sternberg, ESQ.  
No. of Pages 2

**PLEASE SEE  
ATTACHED**

*Collin W. Park*

**COLLIN W. PARK  
PRIMARY EXAMINER  
GROUP 2300**

15

Translation of the attached letter on LuK letterhead

---

**By Telefax**

Darby & Darby  
Professional Corporation  
Attn. Mr. Henry Sternberg  
805 Third Avenue  
NEW YORK, NY 10022-7513  
USA

Bühl, April 2, 2003

US Patent Application Serial No. 08/392,127  
Your Reference: 2338/0A887  
Our Reference: GS 0115/04/012 B US

Dear Mr. Sternberg:

In reference to the above-identified case, the last activities  
in our file are:

our letter to you dated February 6, 1997 (see attachment)  
and  
your invoice dated July 25, 1997.

Please advise what is your latest status in this matter.

Sincerely

LuK Lamellen und Kupplungsbau  
Beteiligungs KG  
Patent Department

*(signature of Dieter Ronnenberg)*

Ronnenberg

November 3, 2003

To Whom It May Concern:

The undersigned hereby declares that he has personally translated the attached documents:

Portions of fax from Dr. H. Grauel, LuK, to Henry Sternberg, dated February 6, 1997,

Fax from Mr. Ronnenberg, LuK, to Henry Sternberg, dated April 2, 2003, and

Fax from Mr. Rotter, LuK, to Henry Sternberg, dated May 15, 2003

and that they are accurate translations of the German documents that are attached to them.

Walter Kropf

Walter Kupper  
Registered Patent Agent  
USPTO Reg. No. 34,954

HS



LuK Lamellen und Kupplungsbau Beteiligungs KG - 77815 Bühl

**Per Telefax**

**DARBY & DARBY**  
Professional Corporation  
Attn. Mr. Henry Sternberg  
805 Third Avenue  
NEW YORK, N.Y. 10022-7513  
U S A

**LuK Lamellen und Kupplungsbau  
Beteiligungs KG**

Industriestraße 3 · 77815 Bühl  
Postfach · 77813 Bühl  
Tel. 0 72 23/941-0 (Zentrale)

Abteilung/Bearbeiter PT/Ron  
Telefon (Durchwahl) 941-7054  
Fax (Durchwahl) 941-149  
Dieter.Ronnenberg@luk.de

Bühl, den 02.04.03

**US Patentanmeldung Serial No. 08/392,127**  
Ihr Zeichen: 2338/0A887  
Unser Zeichen: GS 0115/04/012 B US

Sehr geehrter Herr Sternberg,

bezüglich dem obigen Fall, sind in unserer Akte:  
unser Schreiben an Sie mit Datum 6. Februar 1997 (siehe Anlage)  
und  
Ihre Rechnung mit Datum vom 25. Juli 1997  
die letzten Vorgänge.

Wir bitten um Mitteilung, welches Ihr letzter Stand ist.

Mit freundlichen Grüßen

LuK Lamellen und Kupplungsbau  
Beteiligungs KG  
Patentabteilung

*Dieter Ronnenberg*  
Ronnenberg

Bankverbindungen:  
Deutsche Bank BÜhl  
09/57 700 00, BLZ 662 700 01

Volkbank BÜhl  
1 31 10 00, BLZ 652 014 00

Rechtsform:  
LuK Lamellen und Kupplungsbau Beteiligungs KG  
mit Sitz in 77815 BÜhl

Internet:  
www.LuK.de

1 S 16/0 'AN

651166027165, AN071010W10101 V07

55 11 0002 W10 12

16

Translation of the attached letter on LuK letterhead

---

VIA FACSIMILE

Darby & Darby  
Professional Corporation  
Attn. Mr. H. Sternberg  
805 Third Avenue  
NEW YORK, NY 10022-7513  
USA

Bühl, May 15, 2003

Our Patent Application in the U.S.A. No. 08/392,127  
Title: "Method of Controlling a Torque-Transmitting System".  
Your Reference: 2338  
Our Reference: GS 0115/04/012 B US

Dear Mr. Sternberg:

After we noticed that for a long time following our fax of February 6, 1997 to you there had been no activities whatsoever in the above-referenced case which we still counted among our active cases, we asked you in a letter in February this year to let us know what is your latest status in this matter.

You advised us in a fax of April 8 of the current year, that a Notice of Abandonment exists with a date of May 27, 1997. However, the Notice of Abandonment was not attached to your fax.

Subsequently we asked you in a fax dated April 11 of this year to send us the Notice of Abandonment. The Notice of Abandonment then arrived with a copy of this letter of April 8, 2003.

The matter presents itself to us as follows:



November 3, 2003

To Whom It May Concern:

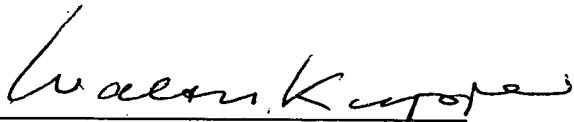
The undersigned hereby declares that he has personally translated the attached documents:

Portions of fax from Dr. H. Grauel, LuK, to Henry Sternberg, dated February 6, 1997,

Fax from Mr. Ronnenberg, LuK, to Henry Sternberg, dated April 2, 2003, and

Fax from Mr. Rotter, LuK, to Henry Sternberg, dated May 15, 2003

and that they are accurate translations of the German documents that are attached to them.

A handwritten signature in cursive script, reading "Walter Kupper", written over a horizontal line.

Walter Kupper  
Registered Patent Agent  
USPTO Reg. No. 34,954



AS

LuK Lamellen und Kupplungsbau Beteiligungs KG - D-77813 Bühl

VIA FACSIMILE  
 DARBY & DARBY  
 Professional Corporation  
 Attn: Mr H. Sternberg  
 805 Third Avenue  
 New York, NY 10022-7513  
 USA

DA 887

LuK Lamellen und Kupplungsbau  
 Beteiligungs KG

Bußmatten 2 · 77815 Bühl  
 Postfach · 77813 Bühl  
 Tel. 0 72 23/941-0 (Zentrale)

Abteilung/Bearbeiter PT/Ro-mcc  
 Telefon (Durchwahl) 0 72 23 /941-410  
 Fax (Durchwahl) 0 72 23/941-149  
 eMail: guido.ege@luk.de

Bühl, den

15.05.2003

Unsere Patentanmeldung in den USA Nr. 08/392,127 vom 22.02.1995

**Titel:** "Verfahren zum Steuern eines Drehmomenten-Übertragungssystems"

**Ihr Zeichen:** 2338

**Unser Zeichen:** GS 0115/04/012 B US

Sehr geehrter Herr Sternberg,

nachdem wir festgestellt hatten, dass lange Zeit in der obigen Anmeldung, die für uns noch zu den laufenden Anmeldungen zählte, nach unserem Fax an Sie vom 06. Februar 1997 keinerlei Aktivitäten erfolgt sind, haben wir Sie mit Schreiben vom 02. dieses Jahres um Mitteilung gebeten, welches Ihr letzter Stand in der Akte ist.

Sie teilten uns mit Fax vom 08. April dieses Jahres mit, dass eine Notice of Abandonment vom 27. Mai 1997 vorläge. Diesem Fax war jedoch die Notice of Abandonment nicht beigelegt.

Daraufhin haben wir mit Fax vom 11. April dieses Jahres gebeten, uns die Notice of Abandonment zuzusenden. Mit einer Kopie dieses Schreibens vom 08. April 2003 kam dann die Notice of Abandonment.

Uns stellt sich die Angelegenheit wie folgt dar:

Mit unserem Fax vom 06. Februar 1997 haben wir Sie gebeten, die Akten an Herrn Kontler zur weiteren Bearbeitung zu übersenden.

Bankverbindungen:  
 Deutsche Bank Bühl  
 06/67 700 00, BLZ 662 700 01

Vollbank Bühl  
 1 31 10 00, BLZ 662 914 00

Rechtsform:  
 LuK Lamellen und Kupplungsbau Beteiligungs KG  
 mit Sitz in Bühl / Baden  
 HRA 1097-SH AG Baden-Baden

Internet:  
 www.LuK.de



14. Mai 2003

Weiterhin haben wir mit gleichem Fax vom 06. Februar 1997 Herrn Kontler gebeten, auf den Prüfungsbescheid vom 12. November 1996 unter Zugrundelegung der in obigem Fax enthaltenen Informationen zu erwidern.

Als Nächstes kam die Notice of Abandonment vom 27. Mai 1997.

Der Prüfungsbescheid vom 12. November 1996 ist also nicht beantwortet worden, obwohl wir in unserem bereits genannten Fax vom 06. Februar 1997 ausführliche Informationen geliefert haben.

Die Notice of Abandonment vom 27. Mai 1997 haben wir zumindest nicht in unserer Akte. Wir gehen auch davon aus, dass sie nie bei uns eingetroffen ist, und sollten Sie anderer Auffassung sein, so lassen Sie uns bitte Ihren Faxbericht zukommen.

Wenn wir wenigstens die Notice of Abandonment erhalten hätten,

Hier-

über wird sicherlich noch eine Diskussion erforderlich sein.

Wir hätten gerne Ihre Stellungnahme, wie Sie die Angelegenheit sehen.

Mit freundlichen Grüßen

LuK Lamellen und Kupplungsbau  
Betelligungs KG  
- Patentabteilung -

G. Rotter

\*\*\*\*\*  
\*\*\* TX REPORT \*\*\*  
\*\*\*\*\*

TRANSMISSION OK

TX/RX NO  
CONNECTION TEL 1849  
SUBADDRESS 011497223941149  
CONNECTION ID  
ST. TIME 04/08 16:46  
USAGE T 01'15  
PGS. SENT 4  
RESULT OK

EMA

ARBY &  
ARBY

PATENT  
ATTORNEY

INTELLECTUAL PROPERTY LAW

THIRD AVENUE  
NEW YORK, NY 10022-7513  
(212) 527-7700  
(212) 753-6237

April 8, 2003

Reference: 2338/0A887

HENRY STERNBERG  
OF COUNSEL  
(212) 527-7755  
hsternberg@darbylaw.com

VIA FACSIMILE- 011 49 7223941149

Herrn Dipl.-Ing. Gerhard Rotter  
Leiter der Patentabteilung  
LuK Lamellen und Kupplungsbau Beteiligungs KG  
Bussmatten 2,  
77815 Bühl,  
Federal Republic Germany

Attn: Mr. Ronnenberg

Re: U.S. Patent Application  
Serial No. 08/392,127  
Your Ref: GS 0115/04/012 B US

Dear Mr. Ronnenberg:

Pursuant to your fax of 2 April, we reviewed the file and found that the most recent correspondence was back in 1997. Since we were never instructed to prepare a Petition to Revive after we received a Notice of Abandonment dated 27 May 1997 (copy enclosed for your information), the application is Abandoned.

Any further questions, please let me know.

Sincerely yours,

\*\*\*\*\*  
\*\*\* TX REPORT \*\*\*  
\*\*\*\*\*

TRANSMISSION OK

TX/RX NO 3070  
CONNECTION TEL 011497223941149  
SUBADDRESS  
CONNECTION ID  
ST. TIME 04/15 09:32  
USAGE T 00'56  
PGS. SENT 2  
RESULT OK

AC

EMA

DARBY &  
DARBY

PROFESSIONAL  
CORPORATION

INTELLECTUAL PROPERTY LAW

110 THIRD AVENUE  
NEW YORK, NY 10022-7513  
(212) 527-7700  
(212) 753-6237

April 8, 2003

Reference: 2338/OA887

HENRY STERNBERG  
OF COUNSEL  
(212) 527-7755  
hsternberg@darbylaw.com

VIA FACSIMILE- 011 49 7223941149 (2 pages)

Herrn Dipl.-Ing. Gerhard Rötter  
Leiter der Patentabteilung  
LuK Lamellen und Kupplungsbau Beteiligungs KG  
Bussmatten 2,  
77815 Bühl,  
Federal Republic Germany

Attn: Mr. Ronnenberg

Re: U.S. Patent Application  
Serial No. 08/392,127  
Your Ref: GS 0115/04/012 B US

Dear Mr. Ronnenberg:

Pursuant to your fax of 2 April, we reviewed the file and found that the most recent correspondence was back in 1997. Since we were never instructed to prepare a Petition to Revive after we received a Notice of Abandonment dated 27 May 1997 (copy enclosed for your information), the application is Abandoned.

Any further questions, please let me know.

N,

**DARBY &  
DARBY**

PROFESSIONAL  
CORPORATION

INTELLECTUAL PROPERTY LAW

805 THIRD AVENUE  
NEW YORK, NY 10022-7513  
TEL (212) 527-7700  
FAX (212) 753-6237

April 8, 2003

Reference: 2338/0A887

**HENRY STERNBERG**  
OF COUNSEL  
(212) 527-7755  
hssternberg@darbylaw.com

VIA FACSIMILE- 011 49 7223941149 (2 pages)

Herrn Dipl.-Ing. Gerhard Rotter  
Leiter der Patentabteilung  
LuK Lamellen und Kupplungsbau Beteiligungs KG  
Bussmatten 2,  
77815 Bühl,  
Federal Republic Germany

Attn: Mr. Ronnenberg

Re: **U.S. Patent Application**  
**Serial No. 08/392,127**  
**Your Ref: GS 0115/04/012 B US**

Dear Mr. Ronnenberg:

Pursuant to your fax of 2 April, we reviewed the file and found that the most recent correspondence was back in 1997. Since we were never instructed to prepare a Petition to Revive after we received a Notice of Abandonment dated 27 May 1997 (copy enclosed for your information), the application is Abandoned.

Any further questions, please let me know.

Sincerely yours,

  
Henry Sternberg

HS:eag

\*\*\*\*\*  
\*\*\* TX REPORT \*\*\*  
\*\*\*\*\*

TRANSMISSION OK

TX/RX NO 2648  
CONNECTION TEL 12394346747  
SUBADDRESS  
CONNECTION ID  
ST. TIME 05/16 09:38  
USAGE T 03' 28  
PGS. SENT 9  
RESULT OK

Emg

To: Mr. Kordler  
From: Ema Gualand  
Fax: 239-434-6747



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO.  
00/307,121 02/23/96 FISCHER R 7308/0552 HS

DARBY AND DARBY  
805 THIRD AVENUE  
NEW YORK NY 10022

ERM1/1112

DUE: February 12, 1997

Decided on 1/12/97 by [signature] for 2304

Decided without file

DATE MAILED: 1/12/97

1/12/97  
5/12/97

This is a communication from the examiner to the applicant.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 6/21/96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 12 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 1-101 are pending in the application.  
Of the above, claims 1-101 are withdrawn from consideration.
- ☐ Claims are have been cancelled.
- ☐ Claims are allowed.
- ☒ Claims 1-40 are rejected.
- ☐ Claims are objected to.
- ☐ Claims are subject to restriction or election requirement.
- ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on Under 37 C.F.R. 1.64 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

To: Mr. Kottler  
From: Ema Gualand  
PAP: 239-434-6747



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO.  
08/392,127 02/22/95 FISCHER R 2338/0599

DARBY AND DARBY  
905 THIRD AVENUE  
NEW YORK NY 10022

E3M1/1112

EXAMINER:

DUE: February 12, 1997

ART UNIT PAPER NUMBER

Declassified on 11/19/97 by JLS for 2304

Docketed without fee

DATE MAILED: 11/12/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

1/12/97  
5/12/97

☒ This application has been examined ☒ Responsive to communication filed on 6/21/96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 67 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 1-101 are pending in the application.

Of the above, claims 41-101 are withdrawn from consideration.

2. ☐ Claims have been cancelled.

3. ☐ Claims are allowed.

4. ☒ Claims 1-40 are rejected.

5. ☐ Claims are objected to.

6. ☐ Claims are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed has been ☐ approved; ☐ disapproved (see explanation).

12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received ☐ been filed in parent application, serial no. filed on

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

ART UNIT 2304

1. This application has been examined in response to Applicants' communication filed on June 21, 1996. Claims 1-101 are currently pending.

2. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

5 3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

4. The restriction requirements mailed on January 18, 1996 (paper number 4) and May 23, 1996 (paper number 6) are incorporated herein.

5. Applicant's election with traverse of Group 1A (claims 1-40) in Paper No. 7 is  
10 acknowledged. The traversal is on the ground that a single novelty search would appear to suffice to locate prior art relevant for determining patentability of claims in all of the groups that. This is not found persuasive because a search required for the Group 1A such as class 364, subclass 424.1, for example, is not required for the Group IV which is directed to a mechanical structure.

15 Thus, the requirement is still deemed proper and is therefore made FINAL. Also, claims 41-101 are withdrawn from further consideration by the Examiner as being directed to non-elected inventions. 37 CFR § 1.142(b).

ART UNIT 2304

6. The disclosure is objected to because of the following informalities:

One of the parent applications referenced on page 2 of the specification is not identified by its serial number. The Applicants are requested to update the continuing data as in the specification as well as in the declaration.

5 Further, the table on page 97 of the specification is more than five inches wide. See 37 CFR § 1.58(c). Correction is required.

7. Claims 1-40 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10 7.1 As per claim 1, "selectively variable" (lines 8-9) is vague and indefinite. Also, it is not clear whether the magnitude of torque being transmitted by the output element is different from the magnitude of torque transmitted by the clutch. Finally, the text starting with "ascertaining and adaptively applying" and continuing to the end of the claim is vague and confusing, and does not appear to make any sense.

5 7.2 As per claim 2, there is no recitation of steps for determining the RPM of the output element, for determining  $k_{corr}$ , for determining  $M_{corr\ pm}$ , for determining  $M_{pm}$ , and for determining  $M_{corr\ wu}$ . These steps are necessary for determining the torque to be transmitted by the clutch. Thus, the claim is incomplete. Also, "at least substantially constant within the entire operating range of the power train" is vague and indefinite, and appears to contradict the disclosure (see  
0 Figure 27).

ART UNIT 2304

7.3 Claim 6 does not make sense and appears to be meant to depend on claim 2, not claim 1.

7.4 Claim 9 is confusing and does not appear to make sense.

7.5 As per claim 14, "can be unequivocally defined by a non-analytical technique" is functional and not supported by the recited means/steps.

7.6 As per claim 15, it is not clear what the "I return flow of fluid" means.

7.7 As per claim 21, see the above rejection of claim 2.

7.8 Claim 22, is confusing and does not appear to make sense.

7.9 As per claim 23, "efficiency" (line 4) and "utilization" (line 7) lack proper antecedent bases.

7.10 Claim 24 is exactly the same in scope as claim 23 because "speed ratios" and "drive ratios" are the same.

7.11 As per claim 25, the exemplary language "such as a combustion engine" makes the scope of the claim indefinite. Also, the text starting with "wherein the magnitude of torque being transmitted" and ending with "regulatable by the computer unit" (lines 7-12) does not make sense. Further, there is no recitation of steps for determining  $k_{\text{corr}}$  and for determining  $M_{\text{pm}}$ . These steps are necessary for determining the torque to be transmitted by the clutch. Thus, the claim is incomplete. Also, "at least substantially constant within the entire operating range of the power train" (lines 18-19) is vague and indefinite, and appears to contradict the disclosure (see Figure 27). Finally, the text starting with "applying the thus ascertained force" and continuing to the end of the claim is confusing and does not appear to make sense.

7.12 As per claims 26-29, see the above rejection of claim 25.

ART UNIT 2304

7.13 As per claim 29, there is no recitation of step for determining the RPM of the output element which is necessary for the recited method.

7.14 As per claim 33, it is not clear to what "that torque" (line 2) refers. The recited undertakings (A)-(D) are vague, confusing, and indefinite in scope. For example, see "such as blocking of the clutch" (line 10).

7.15 As per claim 34, see the above rejection of claim 33.

7.16 As per claim 35, "likely to develop" (line 3) and "likely to entail" (line 7) make the claim vague and indefinite. Also, "which ensures insulation . . ." is functional and not supported by the recited means/steps.

7.17 As per claim 36, see the above rejection of claim 35.

7.18 Claim 37 does not make sense.

7.19 As per claim 38, the claim is incomplete without a step of detecting "indication of intended acceleration of the prime mover." Also, the exemplary language "such as by a change . . ." makes the scope of the claim indefinite.

7.20 As per claims 39-40, see the above rejection of claims 23-24.

7.21 The applicants are advised to establish proper antecedent bases for the terms aforementioned and for all other terms without proper antecedent bases which may exist throughout the claims.

7.22 All the dependent claims are rejected or further rejected for incorporating deficiencies cited above from their respective parent claims.

ART UNIT 2304

8. Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5 Although determination of factors  $k_{corr}$ ,  $M_{corr\ pm}$  and  $M_{corr\ wu}$  are critical to the claimed invention, there is not enough guidance by the present disclosure regarding selection or determination of the above factors to enable one of skilled in the art to make and use the present invention. Since there are three factors that must be selected or determined, the present disclosure does not enable one of skilled in the art to make and use the present invention without  
10 undue experimentation.

9. Because it is not possible for the Examiner to reasonably interpret the scope of the claims in light of the deficiencies cited above, it is deemed inappropriate to reject the claims based on prior art at this time. In re Steele, 134 USPQ 292, 295 (CCPA 1962). The Applicants are not to regard this as an indication of allowable subject matter.

15 10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Collin W. Park whose telephone number is (703) 305-9754. The examiner can normally be reached on Tuesday - Friday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska, can be reached on (703) 305-9704. The fax phone number for this  
20 Group is (703) 308-5357.


SERIAL NO. 8 - 392,127

7

ART UNIT 2304

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

November 7, 1996

  
COLLIN W. PARK  
PRIMARY EXAMINER  
GROUP 2300

SERIAL NO.

08/392,127

GROUP ART UNIT

2304

ATTACHMENT  
TO PAPER NO.

8

## NOTICE OF REFERENCES CITED

APPLICANT(S)

Robert FISCHER et al.

## U.S. PATENT DOCUMENTS

		DOCUMENT NO.	DATE	NAME	CLASS	SUB-CLASS	FILING DATE IF APPROPRIATE
	A	5,029,087	7/02/91	Cowan et al.	364	424.1	
	B	5,058,716	10/22/91	Lippe et al.	192	3.33	
	C	5,272,630	12/21/93	Brown et al.	364	424.1	
	D	5,303,616	4/19/94	Palansky et al.	477	63	8/10/92
	E	5,305,663	4/26/94	Leonard et al.	475	123	8/10/92
	F	5,501,309	3/26/96	Walth et al.	192	3.29	7/27/94
	G	5,553,694	9/10/96	Schulz et al.	192	3.3	9/11/95
	H						
	I						
	J						

## FOREIGN PATENT DOCUMENTS

		DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
	L						
	M						
	N						
	O						
	P						
	Q						

## OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

	R	
	S	
	T	

EXAMINER

Collin W. Park

DATE

11/07/96

\* A copy of this reference is not being furnished with this office action.  
(See Manual of Patent Examining Procedure, section 707.05(a).)

**The drawings submitted with this application were declared informal by the applicant. Accordingly they have not been reviewed by a draftsperson at this time. When formal drawings are submitted, the draftsperson will perform a review.**

**Direct any inquires concerning drawing review to the Drawing Review Branch (703) 305-8404.**

\*\*\*\*\*  
\*\*\* TX REPORT \*\*\*  
\*\*\*\*\*

TRANSMISSION OK

TX/RX NO 2672  
CONNECTION TEL 12394346747  
SUBADDRESS  
CONNECTION ID  
ST. TIME 05/16 09:25  
USAGE T 01'22  
PGS. SENT 3  
RESULT OK

To: Mr. Kontler  
From: Irma Gualand  
Fax 239 434 6747



UNITED STATES DEPARTMENT OF  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADE  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCK
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08/392,127 02/22/95 FISCHER

R 23943467  
EXAMINER

JENSEN, N

ART UNIT	PAPER NUMBER
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DARBY AND DARBY  
805 THIRD AVENUE  
NEW YORK NY 10022

35M1/0523

DUE:

June 22, 1996 (10/22/96)

6

Docteted on 6/5

by ALS

3502  
DATE MAILED:

This is a communication from the examiner in the above-captioned application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

05/23/96

Attorney [Signature]

☐ This application has been examined ☒ Responsive to communication filed on 2.20.96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 0 month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/>   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-101 are pending in the application.

Of the above, claims are withdrawn from consideration.

2. ☐ Claims have been cancelled.

3. ☐ Claims are allowed.

To: Mr. Konte  
From: Ena Qualano  
Fax 212 434-6747



UNITED STATES DEPARTMENT OF  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADE  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCK
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08/392,127 02/22/95 FISCHER

DARBY AND DARBY  
805 THIRD AVENUE  
NEW YORK NY 10022

35M1/0523

EXAMINER	ART UNIT	PAPER NUMBER
JENSEN, N		6

DUE: June 22, 1996 (10/22/96)

Docketed on 6/5/95 by MRS. 3502 DATE MAILED:

This is a communication from the examiner to the applicant.  
COMMISSIONER OF PATENTS AND TRADEMARKS

05/23/96

Attorney

☐ This application has been examined ☒ Responsive to communication filed on 2.29.96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 0 month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/>   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-101 are pending in the application.  
Of the above, claims are withdrawn from consideration.
2. ☐ Claims have been cancelled.
3. ☐ Claims are allowed.
4. ☐ Claims are rejected.
5. ☐ Claims are objected to.
6. ☒ Claims 1-101 are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. filed on
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Serial Number: 08/392,127

-2-

Art Unit: 3502

### **Part III DETAILED ACTION**

#### ***Election/Restriction***

1. Receipt of the Response to the Restriction Requirement, received 20 February 1996, is acknowledged. However, upon reconsideration, it is deemed proper to further restrict Group I (claims 1-40 and 66-71) as described in the following paragraph.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group IA. Claims 1-40, drawn to a method for computerized engine-torque-dependent clutch slip regulation classified in Class 364, subclass 424.01.

Group IB. Claims 66-71, drawn to a torque converter/slip clutch combination wherein the torque transmitted by the clutch is a function of heat or road slope, classified in Class 192, subclass 3.3.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions IA and IB are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IB has separate utility such as use in a system not using engine parameters to determine clutch transmission. See M.P.E.P.


§ 806.05(d).

Serial Number: 08/392,127

-3-

Art Unit: 3502

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Because of the change in the restriction requirement, Applicant is allowed to choose between Inventions IA, IB (as described above), II, III, IV, and V (as described in the Restriction Requirement mailed 18 January 1996, Paper Number 4).
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Jensen whose telephone number is (703) 305-6297. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

  
noj

May 16, 1996

**CHARLES A. MARMOR**  
SUPERVISORY PATENT EXAMINER  
ART UNIT 3502

\*\*\*\*\*  
\*\*\* TX REPORT \*\*\*  
\*\*\*\*\*

TRANSMISSION OK

TX/RX NO. 2624  
CONNECTION TEL 12394346747 (AP)  
SUBADDRESS  
CONNECTION ID  
ST. TIME 05/15 15:50  
USAGE T 01'32  
PGS. SENT 4  
RESULT OK

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## DARBY & DARBY

PROFESSIONAL  
CORPORATION

INTELLECTUAL PROPERTY LAW

805 THIRD AVENUE  
NEW YORK, NY 10022-7513  
TEL (212) 527-7700  
FAX (212) 753-6237

May 15, 2003

Reference: 2338/OA887

HENRY STERNBERG  
OF COUNSEL  
(212) 527-7755  
hsternberg@darbylaw.com

VIA TELECOPIER - 1239-434-6747

Peter K. Kontler, Esq.  
Monaco PH 4  
4401 Gulf Shore Blvd. N.  
Naples, FLA 34103

Re: U.S. Patent Application  
Serial No. 08/392,127

Dear Peter:

We just received a fax from Mr. Rotter (copy of 15 May 2003 enclosed). We meticulously searched the files and were unable to find a copy of your Response to the PTO, which was due on May 12, 1997. We also enclose a copy of an E-mail dated May 12, 1997 sent by Mrs. Pelkowski to Ms. Karaszi, in our docket department. A copy of that E-mail is also enclosed.

Hopefully, you have some record of having responded to the Official Action, because we can find nothing in our files. In any event, please phone us and let us know if you have any records at all concerning the subject matter.

Hope you are both well. Looking forward to hearing from you.

Sincerely, Mrs.



## UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

Paper No. 15

DARBY & DARBY  
805 THIRD AVENUE  
NEW YORK, NY 10022

DUE: December 2, 2003Docketed on 10/10 by DP forDocketed without file ☐Attorney DL

COPY MAILED

OCT 02 2003

4-2-04  
OFFICE OF PETITIONSIn re Application of  
Fischer et al.

Application No. 08/392,127

Filed: February 22, 1995

Attorney Docket No. 2338/0A887

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 29, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely reply to the non-final Office action mailed November 12, 1996. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on February 13, 1997. A Notice of Abandonment was mailed May 27, 1997.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply,
- (2) the petition fee,
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The instant petition does not satisfy requirements (3) and (4) above. Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

The delay in filing the instant petition raises a question as to whether the entire delay in filing a petition under 37 CFR 1.137(b) was unintentional. Petitioner should provide a full explanation for the delay from the date of abandonment until the date the instant petition was filed. Petitioner should provide evidence to establish the entire delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b).<sup>1</sup>

DUE: 10/10/04

10/10/04

See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).